REMARKS

This is responsive to the Office Action dated January 29, 2003 which has been carefully considered. Claims 5-8 stand rejected under 35 U.S.C. § 251 as stated at pages 2-3 of the Office Action. Claim 8 also stands rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Hays '704 patent. Reconsideration of the rejections in light of the preceding amendment and following arguments is respectfully solicited.

Turning first to the rejection of claims 5-8 under 35 U.S.C. § 251, the examiner argues that (1) claims 5-8 no longer contain a certain limitation with respect to the insulating member which was "germane" to the prior art rejection and which was (therefore) "surrendered", and (2) that the narrow scope of the claims in the patent was not "an error" within the meaning of 35 U.S.C. § 251. The rejection is respectfully traversed.

Turning first to the argument that the broadening aspect in the reissue related to subject matter that applicant previously surrendered during prosecution, the Examiner's attention is respectfully directed to *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998), *In re Clement*, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997); and *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 195 (Fed. Cir. 1984), all cases cited by the Examiner in the Office Action. *Hester* clearly acknowledges the exception to the recapture rule on which applicant relies herein, namely, that claims which are both broader and narrower in an aspect that directly relates to the rejection of the original claims avoid the effect of the recapture rule ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule"). *Hester*, 46 U.S.P.Q.2d at 1649, citing *Clement* and *Ball.*

In *Ball Corporation,* the Federal Circuit stated:

> On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the cancelled claims (Id. at 295).

In *Ball Corp.*, like in the instant reissue application, the recapture rule was avoided because the reissue claims were sufficiently narrowed despite the broadened aspect of the claims. 221 U.S.P.Q. at 296.

In the instant application, the claims presented for reissue are **narrower** in scope than the cancelled claims. In fact, reissue claim 5 is substantially identical with cancelled independent claim 21 except that the following limitations have been added which, *in toto*, renders the reissue claim **narrower** in scope than cancelled claim 21. In other words, cancelled claim 21 did **not** contain the following limitations which are present in reissue claim 5:

- the insulating member is only in axial contact with the radially expending surface of the membrane spring, and
- the insulating member is a single, one-piece element which extends circumferentially about the pressure plate.

These limitations are also not present in claims 1-4 of the patent. Thus, there is no question that the scope of reissue claims 5-7 is **narrower** than the scope of the patent claims. Under these circumstances, the recapture rule does not apply at all. *Clement*, 45 U.S.P.Q.2d at 1165 ("In contrast, a reissue claim narrower in scope escapes the recapture rule entirely."). See also *In re Wadlinger*, 181 U.S.P.Q. 826, 830 (CCPA 1974); *In re Petrow*, 159 U.S.P.Q. 449, 451 (CCPA 1968); *In re Willingham*, 127 U.S.P.Q. 211 (CCPA 1960); *Mentor Corp. v. Chloroplast Inc.*, 27 U.S.P.Q. 2d 1521, 1525 (Fed. Cir. 1993) ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule.").

In the instant reissue application, the scope of the reissue claims is also narrower in an aspect that directly relates to the rejections in the original claims (i.e. the structure of the insulating member[1]) so that the recapture doctrine does not apply. This principle operates to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain, through reissue, a scope of protection to which he is rightfully entitled for such overlooked aspects. *Hester Industries Inc. v. Stein*, 46 U.S.P.Q.2d 1616, 1649-50 (Fed. Cir. 1998).

The other independent reissue claim 8 is also narrower than the patent claim in aspects that directly relate to the rejections of the original claims (cancelled claim 27).

The original claim did not contain the following limitations which are present in reissue claim 8:

- the pressure plate has a protrusion which extends axially in the direction of the membrane spring, and
- the insulating member is disposed at said protrusion, and
- the second portion of the pressure plate forms part of the protrusion and is disposed between the insulating member and the membrane spring, and
- the insulating member is a single, one-piece element which extends circumferentially about the pressure plate.

---

[1] The prosecution history focused entirely on the shape, properties and location of the insulating material of applicant's claimed clutch. See discussion of the prosecution history in the Amendment dated January 18, 2001 at pages 4-6 (Paper No. 9).

According to the analysis set forth in *In re Clement*, the first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. Here, the reissue claims are broader and narrower in regard to an aspect (the definition of the insulating member) that directly relates to the rejection of the original claims.

The fact that the reissue claims are broader than the patent claims is no issue since reissue was sought within the two year statutory period. On the other hand, the fact that the reissue claims are narrower in an aspect that directly relates to the rejection of the original claims, renders the recapture rule inapplicable in this case. In other words, the fact that the reissue claims are broader than the patent claims only means that reissue must be sought within two years after grant of the original patent. Reissue claims that are broader in scope than the patent claims can, of course, be obtained. *Mentor* at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule").

The second step of the *Clement* analysis is to determine whether applicant surrendered particular subject matter when the claims were cancelled. There is nothing in the prosecution history which would tend to show that applicant intentionally surrendered certain subject matter. There is no statement in the prosecution history that would tend to show that applicant believed certain subject matter was not patentable. Some of the claims stood rejected, others were indicated as allowable. All applicant did is elect the allowable claims. In fact, when applicant's attorney elected allowable subject matter he stated that "applicant retains the right to pursue broader claims under 35 U.S.C. § 120" (Amendment dated September 29, 1997 at page 16, Paper No. 16). There was no surrender of any subject matter.

Accordingly, since the reissue claims are narrower with respect to an issue germane to the prior art rejection of the original claims and there was no surrender of subject matter during

prosecution, the recapture rule does not apply and withdrawal of the rejection as an improper recapture is respectfully submitted. See also, *Hester Industries*, 46 U.S.P.Q.2d at 1649-50 where the CAFC stated:

> "For example, in *Ball* the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as 'fundamental narrowness') despite the broadened aspect of the claims. 729 F.2d at 1438, 221 U.S.P.Q. at 296").

The same applies here, reissue claims 5-8 include limitations which materially narrow the recited insulating member and which relate thus to an aspect which was germane to the rejection of the original claims thus avoiding the effect of the recapture rule.

The Examiner's argument that "the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251 is also not well taken. As stated in the declaration "[a]n error being relied upon as a basis for this reissue application is that one or more claims are too narrow and that the attorney handling this case failed to appreciate the full scope of the invention". First, the reissue statute is "based on fundamental principles of equity and fairness and should be construed liberally". *In re* Weiler, 790 F.2d 1576, 1579; 229 U.S.P.Q. 673, 675 (Fed. Cir. 1986). Second, *Hester Industries*, a case cited by the Examiner in the Office Action, states that "one of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. **This form of error has generally been accepted as sufficient to satisfy the "error" requirement of Section 251** [emphasis added] (*Hester Industries*, 46 U.S.P.Q.2d at 1647).

Accordingly, applicant's attorney's error is a proper basis to satisfy the "error" requirement of 35 U.S.C. § 251 and the rejection of claims 5-8 under 35 U.S.C. § 251 should be withdrawn and same is hereby respectfully urged.

Turning now to the rejection of claim 8 as anticipated by Hays '704 (Fig. 4), the claim has been amended to clarify that the insulating member forms a layer in contact with and along the radial length of the second portion of the pressure plate. The insulating member in Hays (element 59 in Fig. 4) does not form an insulating layer in contact with and along the radial length of the second portion of the pressure plate (balls 44) as interpreted by the Examiner. Accordingly, the rejection of claim 8 should be withdrawn and same is hereby respectfully solicited.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By _____

Thomas C. Pontani
Reg. No. 29,763
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: June 30, 2003